REMARKS

The specification has been amended to correct typographical errors. It is respectfully submitted that no new matter has been introduced.

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1 and 7 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry.

Claims 13-20 have been added. Claims 1-20 are now pending in this application. Claims 1 , 7, and 20 are the independent claims.

I. The Objection to the Drawings

The drawings were objected to as failing to comply with 37 C.F.R. 1.84(p)(5) because they do not include reference signs 622, 624, 614, and 626 mentioned in the specification. Figure 5b was objected to as failing to comply with 37 C.F.R. 1.84(p)(5) because it included reference signs 522, 524, and 526 not mentioned in the specification.

Herewith submitted is a replacement for the paragraph beginning on page 10, line 6 correcting typographical errors, thereby adding no new matter to the application. The revised paragraph appropriately references signs 522, 524, and 526 of Fig. 5b. The revised paragraph removes erroneous references to signs 622, 624, 614, and 626, thereby removing the grounds for

the drawing objection. Thus, reconsideration and withdrawal of the objection to the drawings is respectfully requested.

Herewith submitted is a revised version of FIG 1, labeled as Prior Art.

II. The Objection to Claims 7-12

Claims 7-12 were objected to for informalities. Claim 7 has been broadened to remove these informalities. Therefore, Applicants respectfully submit that any grounds for this objection, and respectfully request acknowledgment thereof.

III. The Anticipation Rejection

Claims 1, 4-7, and 10-12 were rejected as anticipated under 35 U.S.C. §102(e). In support of the rejection, Chapman (U.S. Patent No. 5,974,027) was cited. This rejection is respectfully traversed.

Chapman fails to establish a prima facie case of anticipation. See MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354 (Fed. Cir. Jan. 6, 2003) ("A claimed invention cannot

be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.")

Specifically, claims 1 and 7, from one of which claims 4-6 and 10-12 ultimately depend, recite "**a second protection SONET ring** to a SONET ring family comprising a first protection SONET ring, the first protection SONET ring distinct from the second protection SONET ring and connected to a first optical transport system line, the second protection SONET ring **connected to a second optical transport system line**". Chapman does not teach expressly or inherently "**a second protection SONET ring** to a SONET ring family comprising a first protection SONET ring, the first protection SONET ring distinct from the second protection SONET ring and connected to a first optical transport system line, the second protection SONET ring **connected to a second optical transport system line**". Accordingly, it is respectfully submitted that the rejection of claims 1 and 7 is unsupported by Chapman and should be withdrawn. Also, the rejection of claims 4-6 and 10-12 is unsupported by Chapman and also should be withdrawn.

IV. The Obviousness Rejection

Claims 2 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chapman (U.S. Patent No. 5,974,027). These rejections are respectfully traversed.

Claims 3 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Chapman (U.S. Patent No. 5,974,027) in view of Fishman (U.S. Patent No. 5,982,517). These rejections are respectfully traversed.

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143.

Each of independent claims 1 and 7 recite "**a second protection SONET ring** to a SONET ring family comprising a first protection SONET ring, the first protection SONET ring distinct from the second protection SONET ring and connected to a first optical transport system line, the second protection SONET ring **connected to a second optical transport system line**". Chapman does not expressly or inherently teach or suggest "**a second protection SONET ring** to a SONET ring family comprising a first protection SONET ring, the first protection SONET ring distinct from the second protection SONET ring and connected to a first optical transport system line, the second protection SONET ring **connected to a second optical transport system line**". Fishman does not overcome the deficiencies of Chapman.

Thus, even if there were motivation or suggestion to combine Chapman with Fishman to arrive at the claimed subject matter (an assumption with which the applicant disagrees), and even if Chapman and Fishman were combinable or modifiable (another assumption with which the applicant disagrees), the cited references do not expressly or inherently teach or suggest **every** limitation of the independent claims.

Accordingly, the rejections of claims 2,3, 8, and 9, each ultimately depending from one of independent claims 1 or 7, are unsupported by Chapman in view of Fishman and should be withdrawn.

CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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